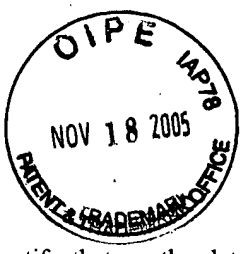

PATENT

I hereby certify that on the date specified below, this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

November 14, 2005 Ayesha J. Shaikh

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	: 09/715,428	Confirmation No.	: 7717
Applicant	: Ole Bentz		
Filed	: November 15, 2000	Attorney Docket No.	: 500845.01
Art Unit	: 2672	Customer No.	: 27,076
Examiner	: Jin-Cheng Wang		
Title	: TEXTURE ADDRESSING CIRCUIT AND METHOD		

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated below.

REMARKS

Claims 10, 17-20, 26 and 28-39 are pending in the present application. In the office action mailed August 26, 2005 (the "Office Action"), the Examiner rejected claims 10, 17-20, and 36-39 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,230,039 to Grossman *et al.* (the "Grossman patent"). The Examiner also rejected claims 26 and 28-35 under 35 U.S.C. 103(a) as being unpatentable over the Grossman patent in view of U.S. Patent No. 6,452,603 to Dignam (the "Dignam patent").

The following previously filed responses to office actions will be referenced as follows: response filed April 17, 2003 ("Response I"); response filed September 9, 2003 ("Response II"); response filed May 12, 2004 ("Response III"); response filed January 11, 2005 ("Response IV"); and response filed July 20, 2005 ("Response V"). Several bases for patentability of the claims of the present application have been presented in these previously filed responses. All of the arguments found in the previously filed responses are maintained by Applicant. The present remarks, however, address a subset of the previously presented arguments in order to provide succinct, concise and focused arguments of clear error in fact. In the event an appeal brief is filed, arguments in addition to the ones discussed herein may be presented.

A summary description of various embodiments of the invention is provided in Response I at pages 3-4 and Response II at page 16. A summary description of the Grossman patent is provided in Response I at pages 4-5, Response II at pages 14-16, and Response III at pages 16-18.

The Examiner's rejection of the pending claims under 35 U.S.C. 103(a) cannot be maintained because the combined teachings of the references cited by Examiner fail to teach or suggest the combination of limitations recited by the respective claims. As known, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See* MPEP 2143.03

With respect to claims 10, 17-20, and 36-39, the Examiner has relied upon the Grossman patent and what appears to be common knowledge in the art as the basis for rejecting the claims under 35 U.S.C. 103(a). *See* the Office Action at pages 12-13. The Examiner further

argues that the "Applicant merely modifies the Grossman's mapping texture coordinates to come up with the claimed invention." *See id.*

Claims 10, 36, and 38 recite limitations for specific calculations of signed texture coordinate values and further recite limitations for a specific way of selecting an output texture coordinate from the input value and the concurrently calculated values.

The Examiner relies on what is purportedly common knowledge in the art for teaching the claim limitations relating to calculating and selecting in claims 10, 36, and 38. The Examiner asserts that "[i]t would have been obvious to one of ordinary skill in the art to have used alternative way [sic] of calculating a plurality of texture values, A, B, which are related to the input texture coordinate value and the texture map size because alternative values may be used as output texture coordinates when a different texture mapping mode is selected." See the Office Action at page 12. Assuming for the sake of argument that the Examiner's position is accurate, the Examiner's argument still fails to render claims 10, 36, and 38 unpatentable because using an "alternative way of calculating a plurality of texture values A, B," does not necessarily teach the *specific* way of calculating as recited in the respective claims. The Examiner fails to provide a reference or the basis on which he relies to conclude that the specific calculation limitations recited in claims 10, 36, and 38 are the "obvious" choice by one ordinarily skilled in the art.

Similarly, with respect to the limitations related to selecting one of the concurrently calculated values, the Examiner argues that "it would have been obvious to one of ordinary skill in the arts" to use the specific selection process recited in the claims without providing either a reference or the basis for the assertion. *See* the Office Action at page 13. That is, even if it assumed that one ordinarily skilled in the art would be motivated to modify the Grossman patent "so that out-of-range texture coordinates can be re-mapped to the range of a texture map including the border of the range of the texture map," *see* the Office Action at page 13, the Examiner fails to establish why the Grossman patent would modified to use the particular selection process as recited in the claims. The Examiner seems to suggest that the specific selection process naturally results from the specific calculation process. *See id.* However, as previously discussed, the Examiner's argument that it would have been obvious to use *alternative* ways of calculating is not the same as arguing it would have been obvious to use the

specific way of calculating recited in the claims. Thus, with the calculation process unknown, relying on it to establish the selection process results in an unknown selection process.

For the foregoing reasons, claims 10, 36, and 38 are patentable over the Grossman patent. Similarly, claim 20, which depends from claim 10, claim 37, which depends from claim 36, and claims 17-19 and 39, which depend from claim 38 are similarly patentable based on their dependency from a respective allowable base claim. Therefore, the rejection of claims 10, 17-20, and 36-39 under 35 U.S.C. 103(a) should be withdrawn.

With respect to the rejection of claims 26 and 28-35 under 35 U.S.C. 103(a), the Examiner's arguments for rejecting claim 28 also exhibits clear factual deficiency. For example, the Examiner rejects claim 28 based on the assertion "Grossman teaches the negate circuit comprising an inverter and an exclusive OR gate," citing col. 10, line 52-col. 11, line 28. See the Office Action at page 36. The material cited by the Examiner does not describe a negate circuit having an inverter and an exclusive OR gate. The cited material is directed to the processing logic illustrated in Figures 5a and 5b and which is applied by the span processors 120. The cited material does not describe any circuitry, or any functionality that suggests a negate circuit having an inverter and an XOR gate. Although not cited by the Examiner in rejecting the specific limitations of claim 28, the Dignam patent appears to be similarly lacking description of a negate circuit having an inverter and an XOR gate. As a result, claim 28 is patentable over the Grossman patent in view of the Dignam patent because the combined teachings fail to teach or suggest the combination of limitations recited by claim 28. The rejection of claim 28 under 35 U.S.C. 103(a) should be withdrawn.

Claims 29-35 are patentable over the Grossman patent in view of the Dignam patent for at least the same reasons previously discussed with respect to claims 10, 36, and 38. That is, claims 29-35 recite calculation circuits configured to perform specific calculations for calculating signed coordinate output values and recite selection logic configured to generate a selection signal in accordance with specific selection limitations that are neither taught nor suggested by the combined teachings of the Grossman patent, common knowledge in the art, and the Dignam patent. Consequently, the rejection of claims 29-35 under 35 U.S.C. 103(a) should be withdrawn.

Applicant requests that the panel find claims 10, 17-20, and 28-39 in condition for allowance. With respect to claim 26, the arguments for patentability are based on interpretation of the Grossman patent, which have been presented in Responses I, II, III, and V. As set forth in *OG Notices: 12 July 2005* describing the new pre-appeal brief conference, such arguments are more suited for the traditional appeal process.

Respectfully submitted,

DORSEY & WHITNEY LLP

Kimton N. Eng
Registration No. 43,605
Telephone No. (206) 903-8718

KNE:ajs

Enclosures:
Postcard
Notice of Appeal (+ copy)

DORSEY & WHITNEY LLP
1420 Fifth Avenue, Suite 3400
Seattle, WA 98101-4010
(206) 903-8800 (telephone)
(206) 903-8820 (fax)

h:\ip\clients\rendition\500845.01\500845.01 pre appeal brief request.doc